



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,547	06/29/2001	Jonathan Sharp	004770.00976	4444
22907 7590 06/26/2008 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER CHANKONG, DOHM	
			ART UNIT 2152	PAPER NUMBER
			MAIL DATE 06/26/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/893,547

**Applicant(s)**

SHARP ET AL.

**Examiner**

DOHM CHANKONG

**Art Unit**

2152

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22, 30, 32-34, 42 and 44-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22, 30, 32-34, 42, and 44-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-884)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

#### **DETAILED ACTION**

1. This action is in response to Applicant's request for continued examination. Claims 22, 30, 32-34, 42, 44, and 45 are amended. Claims 35-41 and 43 are canceled. Claims 46-55 are added. Thus, claims 22, 30, 32-34, 42, and 44-55 are presented for further examination.
2. This action is a non-final rejection.

#### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6.11.2008 has been entered.

#### ***Response to Arguments***

4. Applicant's arguments have been considered but are moot in view of the new ground of rejection set forth in this action. However, since Peng and Srinivasan are still utilized in the new ground of rejection, some of Applicant's arguments are addressed. Applicant amends the independent claims and adds new claims to further limit the claimed invention to apply to downloading adaptation data for modifying games content on the mobile device. Applicant argues that while Peng contains an oblique reference to games, Peng does not expressly teach providing adaptation data comprising software for modifying games content. Applicant also

argues that Peng's provisional application does not teach this feature. Finally, Applicant maintains that there has been a failure to demonstrate that Peng's provisional application supports the Peng patent and therefore the Peng patent is not entitled to the provisional application's earlier filing date. Applicant's arguments have been considered but are not persuasive for the following reasons.

As to Applicant's amendments, one of ordinary skill in the art would have interpreted Peng to teach providing adaptation data comprising software for modifying games content on a mobile device. Moreover, Peng's provisional application properly supports the subject matter that forms the basis for this interpretation. It is noted that rather than addressing the several sections of the provisional application that were recited in previous actions to support the subject matter of the rejection, Applicant continues to maintain the general argument that Peng's provisional application is a "jumbled collection of documents." In the following remarks, efforts are made to correlate subject matter from the Peng patent to the relevant portions of the Peng provisional that support the subject matter in order to address Applicant's concerns. So if Applicant persists in maintaining that Peng fails to support the subject matter relied upon to make the invention, Applicant should address the specific sections cited in the provisional application instead of relying on bare statements to the contrary.

Peng is directed towards managing downloaded applications at a mobile device. As one of ordinary skill in the art would be aware, games would be considered an application. It is noted that Peng's "oblique" reference to this well known fact is located in Peng's description of the prior art and would merely suggest to one of ordinary skill in the art that games are a type of application. Thus, while Peng does not expressly disclose software for modifying games content,

when Peng discloses modifying and updating application content [Peng, column 2 «lines 47-63» and pg. 78-79, section 3.4.1 – specifically, like its child application, the Peng provisional discusses differentially updating applications], it would have been obvious to one of ordinary skill in the art that Peng was referring to all types of applications including games. In other words, the technology that Peng teaches for updating applications is applicable to a wide variety of software applications, including games. The new ground of rejection introduces a prior art reference to support this conclusion.

### ***Specification***

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claims 52-55 discloses a computer-readable medium. Applicant's specification fails to provide antecedent basis this term and therefore the term cannot be given its broadest reasonable interpretation consistent with the specification.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22, 30, 32-34, 42, and 44-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peng (U.S. Patent Number 6,816,944) in view of Srinivasan (U.S. Patent Number 6,460,076), in further view of Narita, U.S. Patent No. 6,761,638.

7. Peng disclosed a system for providing personalized application and data management to mobile devices. In an analogous art, Srinivasan disclosed a system for downloading data files over a data network such that customers are billed based on successful acquisition of the data files. Similarly, Narita is directed towards downloading and updating games at a portable game terminal, such as a cell phone.

8. Concerning claims 22, 33-34, 44, 45, 52, and 54, Peng did not explicitly state computing remuneration data by computing the payment to be made to a content provider on the basis of the level of successful downloads from the server. Peng does use a transaction manager in order to track the progress and status of each transaction. Peng also bills the user for certain transactions, but he is not explicit about how payment to be made is computed.

However, Srinivasan teaches billing customers based on the successful acquisition of data files by the customers. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Peng by adding the ability to compute the payment to be made to a content provider on the basis of the level of successful downloads from the server as provided by Srinivasan. Here the combination satisfies the need for an automated billing process for Charging customers who download information. See Srinivasan, column 1,

line 64 through column 2, line 3. This rationale also applies to those dependent claims utilizing the same combination.

9. Also concerning claims 22, 33-34, 43, 45, 52, and 54, Peng as modified by Srinivasan does not expressly disclose that the adaptation data comprises software for modifying games content on a mobile device. However, downloading data to update and modify a game on a mobile device was a well known feature at the time of Applicant's invention. For example, Narita discloses downloading data to a mobile device for the purpose of updating or rewriting games content by adding new characters and weapons or even new scenarios to the existing game [column 21 «lines 23-33»]. And like Peng, Narita discloses the well known fact that games are a type of application that can be downloaded and updated on a mobile device [column 21 «lines 17-20» | column 23 «lines 8-11»].

Thus, it would have been obvious to one of ordinary skill in the art to have incorporated Narita's teachings of updating gaming applications into Peng's system for downloading and updating applications on a mobile phone. It would have been further obvious to one of ordinary skill in the art to have reasonably inferred, based on both Peng's "oblique" reference noting that games are a type of application as well as Narita's express disclosure, that Peng's invention would have been beneficially applied to a wide variety of downloaded mobile applications.

10. Concerning claims 30, 42, and 44, Peng does not expressly disclose receiving a signal from an operator server that a download of adaptation data has been successfully received. However, such a feature was well known in the art at the time of Applicant's invention. For

example, Srinivasan discloses sending an acknowledgement that download of data is complete [column 6 «lines 27-32»]. It would have been obvious to one of ordinary skill in the art to have modified Peng to include Srinivasan's acknowledgement functionality to properly signal that the user should be billed for the downloaded data.

11. Concerning claims 46-51, while Peng discloses downloading data that updates application content [column 15 «lines 15-20»], Peng does not expressly disclose that said adaptation data modifies adapted game content on said mobile device. However, such downloading data to modified adapted game content was a well known in the feature in the art. For example, Narita discloses downloading programs and data to update adapted game content [column 21 «lines 23-33» - Narita discloses downloading programs that update and rewrite content already stored on the mobile device].

It would have been obvious to one of ordinary skill in the art to have incorporated Narita's teachings of updating gaming applications into Peng's system for downloading and updating applications on a mobile phone. It would have been further obvious to one of ordinary skill in the art to have reasonably inferred, based on both Peng's "oblique" reference noting that games are a type of application as well as Narita's express disclosure, that Peng's invention would have been beneficially applied to a wide variety of downloaded mobile applications.

12. The subject matter from the Peng reference relied upon in the following rejection is directed to providing data that updates content stored on a mobile device, monitoring this provision, allowing access to this data, and using the data to update the content stored on the



mobile device. Applicant is directed to the following sections in Peng's provisional application to support this subject matter: providing data that updates said content to the mobile device [pg. 79 – comparing the application on the mobile device with the new version and differentially downloading files to update the old version], monitoring this provision [pg. 77 – transaction logging and pg. 79 – updating the Application record to signal that the application has been updated with new data], allowing access to this data [pg. 79 – updating the content with the downloaded data], and applying the update data to the content [pg. 79].

13. The following line citations refer to Peng unless otherwise noted. Thereby, the combination of Peng, Srinivasan and Narita discloses:

- «Claim 22»

An apparatus comprising:

a memory for storing adaptation data;

means for allowing access to said adaptation data stored on said apparatus for downloading from said memory of said apparatus to a mobile device (column 5, lines 1-16; Column 7, lines 12-18; and column 8, lines 8-18 and 31-48);

providing adaptation data on a memory of said server (column 15, lines 3-26); allowing access to said adaptation data on said server for downloading from said memory of said server to said portable radio communication device (column 15, lines 3-26);

means for downloading said adaptation data from said memory of said apparatus to said mobile device (column 15, lines 3-26);

means for monitoring downloading of said adaptation data by said mobile device from said memory of said apparatus to provide output data (column 7, lines 38-44);

means for generating data based on the output data of said means for monitoring (column 7, lines 38-44); and

means for computing remuneration data related to the electronic content and the adaptation data based on the generated data, the method including monitoring the volume of downloads that the server is performing and computing the payment to be made to a content provider on the basis of the level of successful downloads from the server (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36), said adaptation data comprising software for modifying games content on said mobile device [Peng, column 1 «lines 35-43» | Narita, column 21 «lines 23-33»].

- <Claim 30>

A portable radio communication device according to claim 42, wherein the acceptance signal contains an indication that the adaptation data has been successfully applied to the electronic content (Srinivasan, column 6, lines 27-36).

- «Claim 32»

An apparatus according to claim 22, wherein the computing means computes remuneration data only if the generated data comprises an indication that the adaptation data has been successfully applied to the electronic content (Srinivasan, column 6, lines 27-36).

- «Claim 33»

A method for downloading adaptation data from a server to a portable radio communication device, said method comprising:

providing adaptation data on a memory of a server (column 15, lines 3-26);

allowing access to said adaptation data on said server for downloading from said memory of said server to a mobile device (column 15, lines 3-26);

monitoring downloading of said adaptation data to said mobile device (column 7, lines 38-44);

generating data based on output data of said monitoring (column 7, lines 38-44); and

computing remuneration data, said computing comprising monitoring the volume of downloads that the server is performing and computing the payment to be made to a content provider on the basis of the level of successful downloads from the server (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36), said adaptation data comprising software for modifying games content on said mobile device [Peng, column 1 «lines 35-43» | Narita, column 21 «lines 23-33»].

- «Claim 34»

A method for downloading adaptation data from a server to a portable radio communication device, said method comprising:

providing adaptation data on a memory of said server (column 15, lines 3-26);

allowing access to said adaptation data on said server for downloading from said memory of said server to a mobile device (column 15, lines 3-26);

downloading said adaptation data from said memory of said server to said mobile device (column 15, lines 3-26);

monitoring downloading of said adaptation data (column 7, lines 38-44);

generating data based on the output data of said monitoring downloading of said adaptation data (column 7, lines 38-44); and

receiving a signal that the download of adaptation data has been successfully received; and registering receipt of said signal in a counter (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36), said adaptation data comprising software for modifying games content on said mobile device [Peng, column 1 «lines 35-43» | Narita, column 21 «lines 23-33»].

- «Claim 42»

An apparatus comprising:

a transceiver, a memory and a controller, said memory being configured to store electronic content, said controller being configurable to cause said transceiver to transmit a request for adaptation data from a server [Figure 3 | column 14 «lines 42-43» : Peng's gateway reads on claimed apparatus], the request comprising an identifier of electronic content stored in said memory and security data [column 2 «line 64» to column 3 «line 8»], said transceiver being configured to receive adaptation data [column 14 «lines 44-45», said controller being configured to modify electronic content stored in said memory by applying to the electronic content the received adaptation data to provide adapted data which is stored in said memory [column 15 «lines 20-26»], said transceiver being configured to transmit an acceptance signal in response to said storing of said adaptation data [Srinivasan, column 6 «lines 27-32»], said electronic content

comprising original games content and said adaptation data comprising software for modifying said games content [column 1 «lines 35-43» and column 15 «lines 15-20» | Narita, column 21 «lines 23-33»].

- «Claim 44»

A method comprising:

downloading adaptation data from the memory of a server to an apparatus comprising a transceiver, a memory and a controller, said memory including electronic content [Figure 3 | column 14 «lines 42-43»];

applying the adaptation data to set electronic content so as to modify the electronic content to provide adapted electronic content [column 15 «lines 15-20»]; and

generating data based on the applying of the adaptation data to the electronic content [column 7 «lines 38-44»], said electronic content comprising original games content and said adaptation data comprising software for modifying said games content [column 1 «lines 35-43» & column 15 «lines 15-20» | Narita, column 21 «lines 23-33»].

- «Claim 45»

An apparatus comprising:

a memory configured to store adaptation data [Figure 3];

a gateway configured to at least selectively allow access to the adaptation data stored on the apparatus for downloading from the memory of the apparatus to a mobile device [Figures 2a, 2b, 2c | Figure 3];

a download controller configured to permit the downloading the adaptation data from the memory of the apparatus to the mobile device [column 7 «lines 46-53» : permitting the download only upon checking the ID of the user of the mobile device]; and

an account register system configured to monitor the volume of downloads from the apparatus [column 7 «lines 38-53»] and to compute remuneration data related to the adaptation data and based on generated data from the mobile device if the generated data includes an indication that the adaptation data has been successfully applied to the electronic content [column 7, lines 44-46 and Srinivasan, column 6, lines 27-36], said adaptation data comprising software for modifying games content on said mobile device [Peng, column 1 «lines 35-43» | Narita, column 21 «lines 23-33»].

- «Claims 46-51, 53, and 55»

An apparatus (and method) further comprising said adaptation data modifies adapted game content on said mobile device [Narita, column 21 «lines 23-33»].

- «Claims 52 and 54»

A computer-readable medium storing a computer program for performing when executed, the following :

allowing access to said adaptation data on said server for downloading from said memory of said server to a mobile device (column 15, lines 3-26);

downloading said adaptation data from said memory of said apparatus to said mobile device (column 15, lines 3-26);

monitoring downloading of said adaptation data to said mobile device (column 7, lines 38-44);

generating data based on output data (column 7, lines 38-44); and

computing remuneration data, said computing comprising monitoring the volume of downloads that the server is performing and computing the payment to be made to a content provider on the basis of the level of successful downloads from the server (column 7, lines 44-46 and Srinivasan, column 6, lines 27-36), said adaptation data comprising software for modifying games content on said mobile device [Peng, column 1 «lines 35-43» | Narita, column 21 «lines 23-33»].

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/  
Examiner, Art Unit 2152